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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,950	09/03/2002	Erin L. Conner	112231	4803
27074	7590	10/19/2007		
OLIFF & BERRIDGE, PLC. P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER OUELLETTE, JONATHAN P	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 10/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com
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Office Action Summary

Application No.

10/064,950

Applicant(s)

CONNER ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wasilewski et al. (US 2002/0105665 A1).**
3. As per **independent Claim 1**, Wasilewski discloses a method of transferring a computer file from a first storage media to a second storage media, comprising: reading the file from the first storage media into a third storage media; writing the file from the third storage media into the second storage media; and charging a transaction fee (Fig.5).
4. As per Claim 2, Wasilewski discloses wherein the second storage media is paper (Figs. 1-3, 5).
5. As per Claim 3, Wasilewski discloses establishing a communication link to a portable electronic device, wherein the first storage media is controlled by the portable electronic device and is in communication with the third storage media through the communication link (Figs. 1-3, 5).

6. As per Claim 4, Wasilewski discloses wherein the communication link is established through an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5).
7. As per Claim 5, Wasilewski discloses establishing a communication link over a computer network to a remote computer, wherein the second storage media is controlled by the remote computer and is in communication with the third storage media over the computer network (Figs. 1-3, 5).
8. As per Claim 6, Wasilewski discloses wherein the computer network is the internet (Figs. 1-3, 5; Para 0009 and 0011).
9. As per Claim 7, Wasilewski discloses establishing a communication link over a computer network to a remote computer, wherein the first storage media is controlled by the remote computer and is in communication with the third storage media over the computer network (Figs. 1-3, 5).
10. As per Claim 8, Wasilewski discloses wherein the computer network is the internet (Figs. 1-3, 5; Para 0009 and 0011).
11. As per Claim 9, Wasilewski discloses establishing a communication link to a portable electronic device, wherein the second storage media is controlled by the portable electronic device and is in communication with the third storage media through the communication link (Figs. 1-3, 5).
12. As per Claim 10, Wasilewski discloses wherein the communication link is established via an IR port, an USB port, or a RS-232 port (Figs. 1-3, 5).

13. As per Claim 11, Wasilewski discloses determining a transaction type, wherein the first storage media and the second storage media are identified according to the determined transaction type (Figs. 1-3, 5).
14. As per **independent Claim 12**, Wasilewski discloses a method of purchasing a first storage media from a vending machine, comprising: selecting a first storage media type; selecting a first storage media amount; charging a transaction fee; and dispensing the first storage media (Figs. 1-3, 5).
15. As per Claim 13, Wasilewski discloses wherein the first storage media is paper, CD-ROM, DVD-ROM, or floppy disk (Figs. 1-3, 5).
16. As per Claim 14, Wasilewski discloses transferring a computer file from a second storage media to the first storage media before the step of dispensing the first storage media (Figs. 1-3, 5).
17. As per Claim 15, Wasilewski discloses establishing a communication link to a portable electronic device, wherein the second storage media is controlled by the portable electronic device and is in communication with the first storage media via the communication link (Figs. 1-3, 5).
18. As per Claim 16, Wasilewski discloses wherein the communication link is established via an IR port, an USB port, or a IR-232 port (Figs. 1-3, 5).
19. As per Claim 17, Wasilewski discloses establishing a communication link over a computer network to a remote computer, wherein the second storage media is controlled by the remote computer and is in communication with the first storage media over the computer network (Figs. 1-3, 5).

20. As per Claim 18, Wasilewski discloses wherein the computer network is the internet (Figs. 1-3, 5; Para 0009 and 0011).
21. As per **independent Claim 19**, Wasilewski discloses a system for purchasing a first storage media from a vending machine, the system comprising: a payment interface; a media distribution device for dispensing the first storage media; and a user input device for selecting one or more of a media type and a media amount (Figs. 1-3, 5).
22. As per Claim 20, Wasilewski discloses wherein the first storage media is paper and the media distribution device is a digital photocopier (Figs. 1-3, 5).
23. As per Claim 21, Wasilewski discloses wherein the media distribution device is an electronic media distribution device, and the first storage media is electronic storage media (Figs. 1-3, 5).
24. As per **independent Claim 22**, Wasilewski discloses a system for transferring a computer file from a first storage media, the system comprising: a second media distribution device for distributing a second storage media; a first media read/write interface for coupling to the first storage media; and a payment interface for accepting payment for a transaction in which the computer file is transferred from the first storage media to the second storage media (Figs. 1-3, 5).
25. As per Claim 23, Wasilewski discloses wherein the second storage media is paper and the second media distribution device is a digital photocopier (Figs. 1-3, 5).
26. As per Claim 24, Wasilewski discloses wherein the second media is portable electronic media and the second media distribution device is an electronic media distribution device (Figs. 1-3, 5).

27. As per Claim 25, Wasilewski discloses a portable electronic device interface, wherein the portable electronic device interface is in communication with the first storage media and wherein the first storage media is controlled by a portable electronic device (Figs. 1-3, 5).

Response to Arguments

28. Applicant's arguments filed 8/1/2007, with respect to Claims 1-25, have been fully considered but are not persuasive. The rejection will remain as FINAL, based on the cited prior art.
29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
30. The Declaration of Conner et al. filed on 8/1/2007 under 37 CFR 1.131 has been considered but is ineffective to overcome Wasilewski et al. (US 2002/0105665 A1).
31. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Wasilewski's reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a

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problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

32. The submitted with the Declaration Exhibit A, which the Applicant relies on to overcome the Wasilewski's reference, does not appear to satisfy conditions listed above. Exhibit A is silent with regard to broad natured process steps (general storage media – applicant should claim exact storage media as disclosed in the declaration exhibit) recited in the independent claims, as well as the three distinct storage media claimed in independent claim 1.
33. Furthermore, the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wasilewski's reference to either a constructive reduction to practice or an actual reduction to practice.
34. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 7333 (Comm'r Pat 1889). Rather, the applicant must show evidence of facts establishing diligence. The Applicant must account for the entire period during which diligence is required. *Gould V. Schawlow*, 363 F.2d 908, 919, 150 USPQ634, 643 (CCPA 1966). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period). Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to

practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

35. Therefore, so as the Declaration does not provide the sufficient evidence to establish a conception of the invention prior to the effective date of the Wasilewski's reference, and does not show diligence from a date prior to the date of reduction to practice of the Wasilewski's reference to either a constructive reduction to practice or an actual reduction to practice, the independent claims and claims depending from them stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US 2002/0105665 A1).

Conclusion

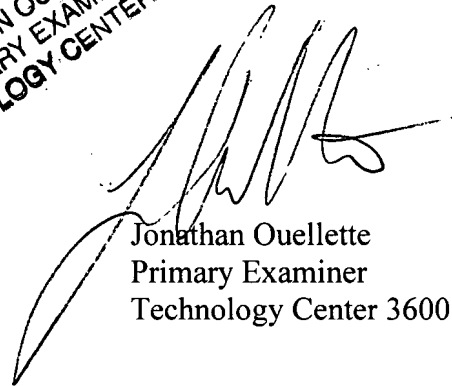
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

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38. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

October 14, 2007

JONATHAN OUELLETTE
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600



Jonathan Ouellette
Primary Examiner
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